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Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

Fees pursuant to the Consolidated Appropriations Act, 2005 (H.R. 4818).

**FEE TRANSMITTAL
for FY 2006**☐ Applicant claims small entity status. See 37 CFR 1.27**TOTAL AMOUNT OF PAYMENT (\$)** \$500.00**Complete if Known**

Application Number	10/764,050
Filing Date	January 23, 2004
First Named Inventor	Dinah B. Quiachon
Examiner Name	Javier G. Blanco
Art Unit	3738
Attorney Docket No.	ENDOV-67115

METHOD OF PAYMENT (check all that apply)☒ Check ☐ Credit Card ☐ Money Order ☐ None ☐ Other (please identify): _____☒ Deposit Account Deposit Account Number: 06-2425 Deposit Account Name: Fulwider Patton LLP

For the above-identified deposit account, the Director is hereby authorized to: (check all that apply)

☐ Charge fee(s) indicated below☐ Charge fee(s) indicated below, except for the filing fee☒ Charge any additional fee(s) or any underpayments of fee(s) under 37 CFR 1.16 and 1.17☒ Credit any overpayments**WARNING:** Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.**FEE CALCULATION (All the fees below are due upon filing or may be subject to a surcharge.)****1. BASIC FILING, SEARCH, AND EXAMINATION FEES**

Application Type	FILING FEES		SEARCH FEES		EXAMINATION FEES		Fees Paid(\$)
	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	
Utility	300	150	500	250	200	100	
Design	200	100	100	50	130	65	
Plant	200	100	300	150	160	80	
Reissue	300	150	500	250	600	300	
Provisional	200	100	0	0	0	0	

2. EXCESS CLAIM FEES

Fee Description	Fee (\$)	Small Entity Fee (\$)
Each claim over 20 (including Reissues)	50	25
Each independent claim over 3 (including Reissues)	200	100
Multiple dependent claims	360	180

Total Claims	Extra Claims	Fee (\$)	Fee Paid (\$)
- 20 or HP =	x	\$50.00	= \$0.00

HP = highest number of total claims paid for, if greater than 20.

Indep. Claims	Extra Claims	Fee (\$)	Fee Paid (\$)
- 3 or HP =	x	\$200.00	= \$0.00

HP = highest number of independent claims paid for, if greater than 3.

3. APPLICATION SIZE FEE

If the specification and drawings exceed 100 sheets of paper (excluding electronically filed sequence or computer listing under 37 CFR 1.52(e)), the application size fee due is \$250 (\$125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).

Total Sheets	Extra Sheets	Number of each additional 50 or fraction thereof	Fee (\$)	Fee Paid (\$)
- 100 =	0	/ 50 0 (round up to a whole number) x	\$250.00	= \$0.00

4. OTHER FEE(S)

Non-English specification, \$130 fee (no small entity discount)

Other (e.g., late filing surcharge): Appeal Brief

\$500.00

SUBMITTED BY

Signature		Registration No. (Attorney/Agent)	38,171	Telephone	310-824-5555
Name (Print/Type)	John V. Hanley	Date	6/2/2006		

This collection of information is required by 37 CFR 1.136. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 30 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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John V. Hanley, Reg. No. 38,171

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of

Dinah B. Quiachon, et al.

Serial No.: 10/764,050

Filing Date: January 23, 2004

For: BIFURCATED MULTICAPSULE
INTRALUMINAL GRAFTING SYSTEM
AND METHOD

Examiner: Javier G. Blanco

Art Unit: 3738

Client ID: ENDOV-67115

Date: June 2, 2006

APPELLANT'S BRIEF

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MS: Appeal Brief Patents
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P. O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This Appellant's Brief is being filed in response to the Final Office action dated
January 3, 2006 and the Advisory Action dated March 15, 2006. The fees required under § 1.17
are submitted herewith. In the event additional fees are required, authorization is hereby
provided to charge our Deposit Account No. 06-2425 any fees due in connection with this paper.

This brief contains items under the following headings, and in the order set forth below:

- I. REAL PARTY IN INTEREST
- II. RELATED APPEALS AND INTERFERENCES
- III. STATUS OF CLAIMS
- IV. STATUS OF AMENDMENTS
- V. SUMMARY OF CLAIMED INVENTION
- VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL
- VII. ARGUMENT
- VIII. CLAIMS APPENDIX

I. REAL PARTY IN INTEREST

The real party in interest in this appeal is the following party: EndoVascular Technologies, Inc., 3200 Lakeside Drive, Santa Clara, CA 95054, which is a wholly-owned subsidiary of Guidant Corporation which is a wholly-owned subsidiary of Boston Scientific Corporation, 1 Boston Scientific Place, Natick, MA 01760.

II. RELATED APPEALS AND INTERFERENCES

With respect to other appeals or interferences that will directly effect, or be directly effected by, or have a bearing on the Board's decision on this appeal, it is to be noted that is believed there are no such appeals or interferences known to the applicant.

III. STATUS OF CLAIMS

The status of the claims in this application are:

A. Total Number of Claims in the Application

The claims in the application are: Claims 33-45

B. Status of All of the Claims

Each of pending claims 33-45 stand as finally rejected under 35 U.S.C. § 103(a).

C. Claims on Appeals

The claims on appeal are each of pending claims 33-45.

IV. STATUS OF AMENDMENTS

On January 3, 2006, claims 33-45 were finally rejected under 35 U.S.C. § 103(a) as being unpatentable. Claims 33-45 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Kubo et al. (5,236,447) in view of Lazarus et al. (5,275,622) and Chuter et al. (5,720,776).

V. SUMMARY OF CLAIMED INVENTION

As recited in the claims of the subject application, the present invention is directed towards a bifurcated graft for treating an aortic aneurysm (See Abstract; Page 6, line 14 et seq.). In one aspect, the bifurcated graft includes a body having a trunk or main tubular member 170, a first leg 171 and a second leg 172 (See Page 35, line 5 et seq.).

Moreover, the bifurcated graft of the present invention includes a plurality of rings which include apices (See FIGS. 17, 40 and 41; reference numerals 175, 176, 178, 179, 275). Certain of the apices can further include a torsion spring 180.

Additionally, as best seen in FIGS. 40 and 41, a plurality of rings in the form of attachment systems 275 can be placed within the legs of the bifurcated graft (See Page 62, line 16 et seq.).

VI. GROUND OF REJECTION TO BE REVIEWED ON APPEAL

Whether claims 33-45 were improperly rejected under 35 U.S.C. § 103(a) as being unpatentable over Kubo et al. in view of Lazarus et al. and Chuter et al.

VII. ARGUMENT

A. Overview

In finally rejecting claims 33-45 under § 103, the Examiner stated that the Kubo et al. reference discloses the invention as claimed except for "particularly disclosing each rings as comprising a plurality of alternating apices." The Examiner then concluded that the structure disclosed in Kubo et al. could be modified to include the teachings of Lazarus et al. and Chuter et al. because bifurcated grafts comprising rings having a plurality of alternating apices were "already known in the art" and it would have been "obvious to a person having ordinary skill in the art at the time the invention was made to have combined the teachings of a bifurcated graft comprising rings having a plurality of alternating apices...in order to improve and/or reinforce the mechanical attachment of the bifurcated graft to a vessel wall."

It is respectfully submitted, however, that there is a lack of motivation or suggestion in the Kubo et al. reference to modify its disclosed structure in view of the teachings of the Lazarus et al. and Chuter et al. references as proffered by the Examiner. Further, it is respectfully submitted that the Kubo et al. reference actually teaches away from incorporating rings having a plurality of alternating apices to "improve and/or reinforce the mechanical attachment" of a graft to a vessel wall.

Significantly, the Kubo et al. patent is concerned with providing an artificial tubular internal organ having high resistance to deformation and good air tightness as well as being

capable of being incorporated into tissue after implantation to provide good adhesion with surrounding tissues (Col. 2, ln. 47 et seq.). To accomplish fixing the disclosed implanted artificial tubular organ in a body after implantation, the combined use of absorbable and non-absorbable yarns is incorporated into the Kubo et al. device so that when the absorbable yarns are dissolved and absorbed into the body, pores are formed between the remaining non-absorbable yarns into which granulation tissues surrounding the artificial tubular organs enter thereby closing the openings of the fabric (Col. 6, ln. 8 et seq.). The Kubo et al. reference further states that the connecting portions (3) are arranged to "prevent supporting frame from excess expansion in the axial direction, as well as prevent aberration of the ring portions, thus making it possible to improve the resistance to deformation" (Col. 4, ln. 14 et seq.). Accordingly, there is no suggestion in Kubo et al. that any problem would be addressed by incorporating into the disclosed structure, rings having a plurality of alternating apices and in fact, the Kubo et al. reference contemplates a supporting frame having a configuration which would not suffer from excess expansion and which is resistant to deformation.

It is significant to the present application that MPEP 2145 states that there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify or combine referenced teachings. It is additionally to be noted that MPEP 2143.01 states that "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination" and that "A statement that modifications of the prior art to meet the claimed invention would have been 'well within the ordinary skill of the art at the time the claimed invention was made' because references relied upon teach all of the aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima*

facia case of obviousness without some objective reason to combine the teachings of the references." Further, the MPEP states that "The level of skill in the art cannot be relied upon to provide the suggestion to combine the references."

It is also believed to be highly significant to the rejection of claims 33-45 that MPEP 2143.01 additionally states that "If the proposed modification or combination of the prior art would change the principle operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious."

In the present situation, it is respectfully submitted that the Examiner has impermissibly relied upon the level of skill in the art to provide the suggestion to modify the Kubo et al. reference to include rings having a plurality of alternating apices as is recited in each of pending claims 33-45. Clearly, there is no acknowledgement in the Kubo et al. reference that a problem exists or one would be solved by incorporating rings with a plurality of alternating apices into the disclosed Kubo et al. device.

Moreover, in any event, the Kubo et al. reference is concerned with providing a device with improved resistance to deformation and thus, incorporating rings with alternating apices especially apices comprising a helical coil as suggested by the Examiner, would be contrary to the import of the Kubo et al. reference. That is, the modification proposed by the Examiner would in contradiction to the requirements of MPEP 2143.01, change the principle operation of the approach taught by Kubo et al.

Finally, since Kubo et al. teaches the combined use of absorbable and non-absorbable yarns to accomplish after implantation affixation, it is respectfully submitted that the Examiner has not provided sufficient evidence to support a conclusion that rings with alternating apices

would "improve and/or reinforce the mechanical attachment" of the Kubo et al. device within a body organ.

Accordingly, it is respectfully submitted that each of pending claims 33-45 are allowable over the cited references.

CONCLUSION

For all the reasons stated above, Applicant respectfully submits that the Examiner has erred in rejecting claims 33-45. It is respectfully requested that the Board reverse the rejection of claims 33-45 and allow claims 33-45 to issue.

Respectfully submitted,

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VIII. CLAIMS

Claims 1-32 (canceled)

Claim 33 (previously presented): A bifurcated graft configured to treat an aortic aneurysm, comprising:

a bifurcated body including a trunk, a first leg and a second leg;

a first ring attached to the trunk;

a second ring and a third ring each attached to the first leg; and

a fourth ring and a fifth ring each attached to the second leg;

wherein at least one of the first ring, second ring, third ring, fourth ring and fifth ring includes a plurality of alternating apices.

Claim 34 (previously presented): The bifurcated graft of claim 33, wherein each of the rings are self-expanding.

Claim 35 (previously presented): The bifurcated graft of claim 33, the bifurcated graft defining an internal surface, wherein each of the rings are configured within the internal surface of the graft.

Claim 36 (previously presented): The bifurcated graft of claim 33, the first ring comprising at least one vessel wall engaging member.

Claim 37 (previously presented): The bifurcated graft of claim 33, the second ring comprising at least one vessel wall engaging member.

Claim 38 (previously presented): The bifurcated graft of claim 33, the fourth ring comprising at least one vessel wall engaging member.

Claim 39 (previously presented): The bifurcated graft of claim 33, each of the rings comprising a plurality of alternating apices.

Claim 40 (previously presented): The bifurcated graft of claim 39, comprising a helical coil configured at each of the plurality of alternating apices.

Claim 41 (previously presented): The bifurcated graft of claim 33, wherein the first leg is longer than the second leg.

Claim 42 (previously presented): The bifurcated graft of claim 33, wherein the second ring and third ring are spaced longitudinally along the first leg.

Claim 43 (previously presented): The bifurcated graft of claim 33, wherein the fourth ring and fifth ring are spaced longitudinally along the second leg.

Claim 44 (previously presented): The bifurcated graft of claim 33, wherein each of the rings define continuous closed structures.

Claim 45 (previously presented): The bifurcated graft of claim 33, wherein at least the second ring and fourth ring are permanently attached to the bifurcated graft prior to placement thereof at an aortic bifurcation.